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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91211255
Party	Defendant Shively, Adam
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Submission	Answer
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Attachments	Opposition No. 91211255- ANSWER TO NOTICE OF OPPOSITION.pdf(154779 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Forged Threadworks, Inc.)	
Opposer)	
)	
v.)	Opposition No. 91211255
)	
)	
Adam Shively,)	
Applicant.)	MARK:
_____)	FORGED BY IRON

ANSWER TO NOTICE OF OPPOSITION

Adam Shively ("Applicant"), owner of Federal Trademark Application Serial No. 85721792 for the mark FORGED BY IRON (hereinafter "Applicant's Mark"), by and through Counsel, Pinnacle IP Strategies, LLC, to the Notice of Opposition filed on June 24, 2013 by Forged Threadworks, Inc. (hereinafter "Forged Threadworks" or "Opposer"), and assigned Opposition No. 91211255 hereby provides this Answer of Applicant.

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 1 of the Notice of Opposition. Accordingly, Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 2 of the Notice of Opposition, specifically whether Opposer is the current correct and proper owner of the claimed registrations, and whether each registration is currently valid and subsisting. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

3. Denied, as Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 3, specifically whether Opposer has

marked its products, whether such markings are clear and/or prominent, whether Opposer has any sales and/or whether any such sales are “extensive”, whether consumers recognize Opposer’s mark, whether any such consumers recognize Opposer’s mark as denoting a “unique standard of high quality”, whether Opposer’s mark has acquired a “wide and favorable” reputation, and whether there is any measurable goodwill associated with Opposer’s mark. Since Applicant can neither admit nor deny the paragraph as written, Applicant must deny.

4. Admitted.

5. Denied, as Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 5, in particular whether (if and when) Opposer has used its mark(s) in commerce, whether any such use by Opposer has been valid and continuous since any alleged date of first use, whether Opposer has abandoned the mark(s), and the extent to which any of Opposer’s alleged rights in the FORGED mark are superior to those of Applicant. Accordingly, Applicant can neither admit nor deny the paragraph as written, thus Applicant must deny.

6. Denied. Applicant is without knowledge or information sufficient to form a belief as to the truth of allegations contained in paragraph 6 of the Notice of Opposition, specifically what goods are offered by Opposer and what the natural zone of expansion of Opposer’s goods may be. Applicant can neither admit nor deny the paragraph as written, accordingly, Applicant must deny.

7. Denied.

8. Admitted that Applicant is not affiliated with or connected in any way to Opposer. Applicant is without knowledge or information sufficient to form a belief as to what Opposer has or has not consented to and thus the further allegations of paragraph 8 are denied.

9. Denied.

10. Denied.

FURTHERMORE, Applicant sets forth the following in support of its position:

11. Applicant's mark is unique and distinctive.

12. The wording in Applicant's mark and Opposer's mark(s) are different.

13. Opposer's FORGED THREADWORKS mark contains the word "THREADWORKS" not present in Applicant's mark.

14. Applicant's mark contains the word "BY" not present in Opposer's marks.

15. Applicant's mark contains the word "IRON" not present in Opposer's marks.

16. Applicant's mark contains design elements not present in Opposer's marks.

17. Applicant's mark and Opposer's mark(s) are different in appearance.

18. Applicants' mark and Opposer's mark(s) are different in spelling and sound.

19. Opposer asserted during prosecution of its FORGED mark that "the commercial impression of FORGED is that of a fraudulent imitation." Applicants' FORGED BY IRON mark and Opposer's mark(s) are thus different in meaning and create completely different commercial impressions.

20. "FORGED" is a common phrase in relation to the making or fabrication of vast variety of goods.

21. "FORGED" is registered in multiple trademarks for apparel-related goods and services not owned by nor used with consent of Opposer.

22. "FORGED" is used in commerce by third parties as part of multiple trademarks for apparel-related goods and services not owned by nor used with consent of Opposer.

23. Opposer is not the senior user or registrant amongst the various users of the "FORGED" marks.

24. Applicant's goods and Opposer's goods are not marketed through the same channels of trade.

25. Applicant's mark does not and is not likely to cause confusion, mistake or deception to consumers as to the source of Opposer's goods or services, or the origin, sponsorship or approval of Applicant's good or services.

26. Applicant's mark does not and is not likely to falsely suggest an affiliation, connection, or association between Opposer and Applicant.

MOREOVER, Applicant further submits that the Opposer's request is affirmatively barred in accordance with the following:

FIRST AFFIRMATIVE DEFENSE

Estoppel

27. During prosecution of its FORGED trademark application before the United States Patent and Trademark Office ("USPTO"), Opposer argued that its application should be allowed to proceed over a likelihood of confusion rejection because (emphasis added):

the FORGED portion of the FORGED IN THE REPUBLIC OF LOS ANGELES mark *is less unique and has been substantially weakened*. With its recent approvals, *the PTO has determined that consumers are capable of distinguishing between the multiple FORGED marks in Class 025*.

28. In addition to the mark cited in the refusal by the Examiner, Opposer cited three issued registrations for marks in International Class 25 containing the name "FORGED" including its own FORGED THREADWORKS (as well as FORGED IDENTITY, Serial No. 77/428,607; and FORGED IDENTITY (+Design); Serial No. 77/539,641) in support of its 'substantial weakening' argument for registration.

29. Opposer thus relied on the presence of those four prior registrations to argue that its

FORGED mark is a satisfactory addition to the already existing field of FORGED marks already peacefully coexisting in the clothing field.

30. In procuring its own mark, Opposer represented to the USPTO that “the PTO has commonly allowed registration of multiple marks containing a single common term in Class 25 for similar goods.”

31. In distinguishing authority (seven cases) cited by the Examiner in his refusal, Opposer argued that although the goods (in Class 25 in each of the cited cases) were related, “the marks themselves were either identical [in 5 of the 7 cases] or differed by only one or two letters [in the remaining 2 of 7 cases].”

32. In view of the positions adopted by the Opposer, and arguments made by Opposer to the PTO, Opposer’s trademark application was allowed to proceed to registration.

33. In direct contradiction of its previous positions and statements before the USPTO, Opposer now asserts that Applicant’s FORGED BY IRON, a composite FORGED mark with design elements (and which differs from FORGED by 2 words and 6 letters) should be denied registration because of likelihood of confusion with Applicant’s FORGED or FORGED THREADWORKS registrations in International Class 25.

34. Accordingly, based on the equitable doctrine of estoppel, Opposer is barred and by legal and equitable right ought to be barred from taking this contradictory, inconsistent, and indefensible position.

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board deny the Opposition and permit registration of Applicant’s proposed mark in Application Serial Number 85721792 in the United States Patent and Trademark Office.

Applicant hereby appoints Scott E. Scioli, a member of the Bar of the Commonwealth of Pennsylvania, at the firm of:

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to act as attorney in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office, and in the United States courts in connection with this opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

Respectfully submitted,

Dated: August 2, 2013

/Scott E. Scioli/

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Attorney for Applicant

CERTIFICATE OF SERVICE

I hereby certify that a true and accurate copy of ANSWER TO NOTICE OF OPPOSITION has been served on the following by delivering said copy on August 3, 2013, via First Class Mail, postage prepaid, to counsel for Opposer at the following address:

Ben T. Lila, Esq.
Mandour & Associates, APC
16870 West Bernardo Drive, Suite 400
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By:

/Scott E. Scioli/

Scott E. Scioli, Esq.